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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,125	01/19/2001	Jonathan E. Lowthert	42390P10483	9472

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EXAMINER
RAMAN, USHA

ART UNIT	PAPER NUMBER
2623	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	09/766,125	LOWTHERT ET AL.
	Examiner	Art Unit	
	Usha Raman	2623	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *18 September 2006*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>62-90</u> is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>62-90</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a) ☐ All b) ☐ Some * c) ☐ None of:

  1. ☐ Certified copies of the priority documents have been received.

  2. ☐ Certified copies of the priority documents have been received in Application No. _____.

  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Response to Arguments

Applicant's arguments with respect to claims 62 and 79 have been considered

but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

2. (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth

in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

art are such that the subject matter as a whole would have been obvious at the time the invention was

made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall

not be negatived by the manner in which the invention was made.

3. Claims 62, 63, 65, 66, 69-74, 77, and 79-90 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Knepper et al. (US Pre Grant Pub. 2001/0042249) in view

of Rosenberg et al. (US PG Pub. 2002/0100041).

In regards to claim 62, Knepper discloses a system comprising:

A transmitter to transmit an info segment (instruction set) including a content

identifier to specify one particular content item (entertainment file such as movie or a

show), the info segment also including an interruption point specifier (EADOK,

EMAXAD tags)that causes the display of an advertisement to replace the display of

the one particular content item (see Knepper: [0060] and [0065]), such that the place

in the content where the replacement might happen during use of the one particular

content item is not known (i.e. ads maybe placed randomly within a show, see

Knepper: [0080] and [0084])

A storage (105) to store the info segment (instruction set) until the info segment is transmitted to a receiver. See Knepper: [0026].

Knepper is silent on detection of a condition during playback to determine the placement of the ad.

In a similar field of endeavor, Rosenberg discloses the step of detecting a condition during user playback of stored content, (the condition being a pause mode), upon the occurrence of which, an ad is displayed to the user. The ad placement is therefore dynamic and not predetermined because it is based on user playback controls (in this case pause), which is not known ahead of time. See abstract and [0009] in Rosenberg.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Knepper in view of Rosenberg by displaying an ad to the user when the user has paused the content item, thereby drawing the user's attention towards the ad, when user's attention is away from the content item. In regards to claim 63, Knepper discloses that the storage stores an info segment including a plurality of fields, one field comprising said interruption point specifier (tags), another field selected from the group consisting of a permitted ad type specifier (ratings), and a prohibited ad type specifier (due to association, see [0061] and [0072]); and

The transmitter transmits info segment separately from the content item (content maybe pre-cached, while info segment is delivered upon request for playback; see [0009] and [0011].

In regards to claim 65, while Knepper discloses that media files maybe delivered to the user over a variety of communications networks (see [0091], Knepper is silent that the system can be a television broadcaster.

Examiner takes official notice that is well known to delivery media files over a television network by television broadcaster.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Knepper to include a television broadcaster, thereby providing media and targeted advertisements to television viewers.

In regards to claims 66, and 82, the transmitter (server) transmits the info segment ("instruction set" for correlating advertisements with media programs) to the receiver upon request. See Knepper: [0011], [0014], [0026].

In regards to claim 68, the system of Knepper further includes an info segment generator (i.e. to create the instruction set prior to transmitting to client) to insert a content identifier and an interruption point specifier in said info segment (the instruction set further contains content identifier to identify primary content being played and interruption point specifier to indicate where ads should be placed). See Knepper: [0009], [0034].

In regards to claims 69, 73 and 81, the system includes ad entry generator (since ad entries are created by the server in the instruction set, the system inherently comprises an ad entry generator) to insert said interruption point specifier in said info segment as an ad entry parameter (see Knepper: [0034], [0053], [0054]), and to insert another ad entry parameter (association 609) consisting of a permitted

ad type specifier (i.e. type of advertisement that may be appropriate for a given entertainment file). See Knepper: [0061].

In regards to claim 70, the system receives at the receiver (i.e. the client 203) the info segment from an external source (i.e. server 207). See Knepper: [0034]

In regards to claim 71, Knepper discloses a method comprising:

Associating one info segment (instruction set) with one particular content item (entertainment file such as movie or a show);

Associating the interruption point indicator (EADOK, EMAXAD tags) with the one info segment, the interruption point indicator will cause an advertisement to be displayed in place of the one particular program content item (see [0060], [0065]), the placement of any advertisement during playback of the content is not predetermined (i.e. ads maybe placed randomly within a show, see Knepper: [0080] and [0084]) when the interruption point indicator is associated with the info segment. Delivering the info segment together with the interruption point indicator to a receiver (see [0009]).

Knepper is silent on a condition that if satisfied will cause the placement of the advertisement due to satisfaction of the condition.

Rosenberg discloses the step of detecting a condition during user playback of stored content, (the condition being a pause mode), upon the occurrence of which, an ad is displayed to the user. The ad placement is therefore dynamic and not predetermined because it is based on user playback controls (in this case pause), which is not known ahead of time. See abstract and [0009] in Rosenberg.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Knepper in view of Rosenberg by displaying an ad to the user when the user has paused the content item, thereby drawing the user's attention towards the ad, when user's attention is away from the content item.

In regards to claim 72, Knepper includes the step of inserting a content identifier (entertainment clip name) in said info segment (instruction set), the content identifier to indicate the one particular content item (i.e. the entertainment file such as movie, or a show) with which said info segment is associated. See Knepper: [0009], [0034].

In regards to claim 74, see claims 66. In further regards to claim 74, the transmitter transmits info segment separately from the content item (content maybe pre-cached, while info segment is delivered upon request for playback; see [0009] and [0011]

In regards to claim 77, Knepper discloses delivering the instruction set over computer network, particularly the Internet, which is a packet switched network. See abstract, [0002].

In regards to claim 79, Knepper discloses a computer readable medium storing instructions that (instruction set), are executed to enable a system to:

Associate an info segment (instruction set) with a content item (entertainment object); see Knepper: [0014]

Associate an interruption point indicator with said info segment (EMAXAD,

EADOK tags),, wherein the point at which the advertisement is displayed prior to use

of the content is unknown (see Knepper: [0080] and [0084]) and

Deliver said info segment including said interruption point indicator to a

receiver. See [0009].

Knepper is silent on the step of identifying a detectable condition during the

use of the content item and if detected would cause an advertisement to be

displayed, and if not detected, no advertisement will be displayed.

Rosenberg discloses ad rules indicating that upon detection a condition

during user playback of stored content, (the condition being a pause mode), upon

the occurrence of which, an ad is displayed to the user. The ad placement is

therefore dynamic and not predetermined because it is based on user playback

controls (in this case pause), which is not known ahead of time. See abstract and

[0009] in Rosenberg. Rosenberg also discloses that at an ad will only be played

when the user enter pause mode (see step 1002 in fig. 10, see [0116]). Therefore if

the user does not enter pause mode, the pause ad will not be displayed.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system of Knepper in view of Rosenberg by displaying an ad

to the user when the user has paused the content item, thereby drawing the user's

attention towards the ad, when user's attention is away from the content item.

In regards to claim 80, Knepper discloses the method of enabling the system

to insert a content identifier in the info segment, the content identifier indicating the

content item with which to associate the info segment (server creates a instruction for an entertainment file).

With regards to claim 83, Knepper discloses that instructions maybe downloaded from server to client preferably upon request from the user. See [0011]. Knepper however does not disclose that the server uses a push method to download the info segment to the receiver. Examiner takes official notice that it was well known for servers to push data files to client systems for client access files when they're off line. It would have been obvious to further modify the system by pushing the data from the server to the client so that the client can access the instruction set during offline times.

With regards to claim 84, Knepper discloses that a wide variety communications networks maybe used for delivering the various data files. See [0092]. While the system doesn't specifically disclose using airwave, the examiner takes official notice that transmission of content over airwaves were well known in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by distributing data over airwave, so that the advertisements can be targeted to users receiving broadcast over airwave.

With regards to claim 85, Knepper discloses that the communications method over which the instruction set is received is over the Internet. See [0014]. The instruction is therefore delivered over a packet switched network (i.e. the Internet is a TCP/IP application).

With regards to claim 86, Knepper discloses that the instruction set is downloaded from server storage to the client. Examiner takes official notice that it was well known at the time of the invention to write data on a transferable recordable medium, and deliver the recordable medium to the user. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by writing the data, including the instruction set on a transferable recordable medium, and delivering the recordable medium to the user. The motivation is to target advertisements to consumers of the recorded medium.

With regards to claims 87, 88, and 90, the interruption point specifier identifies a play specific condition with info segment (i.e. Pause mode ad, see Rosenberg: [0103]).

With regards to claim 89, the system is a computer. See [0029].

4. Claims 64, 67, 75-76 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper et al. (US Pat. 2001/0042249) in view of Rosenberg et al. (US PG Pub. 2002/0100041) and further in view of Zigmond et al. (US Pat. 6,698,020).

In regards to claim 64, Knepper is silent about storing an electronic program guide in the storage, having a program identifier and an associated info segment.

Zigmond discloses storing an EPG at the subscriber premises having a program identifier (see Zigmond: column 10, lines 64-67, column 11 lines 1-2) and an associated "info segment" (see Zigmond: column 11, lines 43-47) that determines

what advertisements should be placed in the program identified by the program

identifier.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system of Knepper by storing an EPG at the user premises,

thereby providing a cataloged listing of programs available to the user.

In regards to claims 67, and 75, Knepper does not disclose that the

transmitter transmits info to the receiver without request.

Zigmond discloses the step of transmitting info segment (containing ad rules

for targeting) that are transmitted to the receiver without request. See Zigmond:

column 12, lines 1-14.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system of Knepper to include the mechanism of "pushing" the

info segment to the receiver, thereby enabling the targeting of advertisements to

television audiences.

In regards to claims 76, Knepper discloses the step of delivering the

instruction set over communications network (see [0092]), however is silent on

delivering the info segment over airwaves.

Zigmond discloses delivering the info segment (ad selection criteria)

advertisement delivery channels, including broadcast signals (i.e. airwave). See

Zigmond: column 12, lines 1-9.

It would have been obvious to one of ordinary skill at the time of the invention

to modify the system in view of Zigmond by delivering the info segment over the

airwaves thereby delivering it to broadcast television viewers.

In regards to claims 78, Knepper is silent on delivering the info segment on a

recordable medium.

Zigmond discloses delivering pre-installed ad selection criteria in ad insertion

devices (and therefore are recorded onto the devices on a recordable medium). See

Zigmond: column 12, lines 6-12.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system by delivering the info segment on a recordable

medium as taught by Zigmond, thereby enabling targeted advertisements for

programs in a recordable medium.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory action

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from

the mailing date of the advisory action. In no event, however, will the statutory

period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Usha Raman whose telephone number is (571) 272-

7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The

fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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272-1000.

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